



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,064	09/13/2000	Donald Eugene Brodnick	GEMS8081.040	7626

27061 7590 02/04/2003

ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (GEMS)
14135 NORTH CEDARBURG ROAD
MEQUON, WI 53097

EXAMINER

KHAN, OMAR A

ART UNIT PAPER NUMBER

3762

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,064

Applicant(s)

BRODNICK ET AL.

Examiner

Omar A Khan

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/19/2002 have been fully considered but they are not persuasive.

Applicant's arguments regarding the inferentially included elements "a plurality of lead wires" and "a health care provider" in Claim 1 have been fully considered but are not persuasive. The claim is vague and indefinite for not positively reciting a plurality of lead wires. The inferentially included element "a plurality of lead wires" renders the scope of the claimed invention unclear as it is not distinctly evident whether or not the plurality of lead wires are being claimed. If a plurality of lead wires is not being claimed, Examiner suggests, "adapted to be connected to a plurality of lead wires". If a plurality of lead wires is being claimed Examiner suggests a positive recitation of the lead wires. In addition, Claim 1 does not cite that the wireless communication interface is *capable* of transmitting patient data to a health care provider. Claim 1 cites "a wireless communication interface coupled to...transmit patient ECG data to a health care provider. Examiner suggests -a wireless communication interface coupled to receive patient ECG data from the ECG monitor and capable of transmitting patient ECG data to a health care provider-.

In response to applicant's argument that David does not disclose a portable, on-demand ECG monitor or that Bornn does not disclose an on-demand ECG monitor, David and Bornn are designed for use with various ECG monitors, the on-demand type being one example, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

Art Unit: 3762

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant's remaining arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite for citing the limitations "a plurality of lead wires", and "a health care provider" which are inferentially included and not positively recited in the claims. Further, the scope of the claimed invention is unclear as it is not explicitly evident if the claims contain these limitations.

Art Unit: 3762

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 2, and 11-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Murphy (US Patent No 6,409,661).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over David et al. David discloses all of the claimed limitations but does not explicitly speak to a 12-lead ECG apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ECG monitoring of David to include a 12-lead ECG apparatus since it was well known in the art to use a 12-lead ECG apparatus for producing a complete and easily readable electrocardiograph data record which, in turn, results in more accurate diagnoses by the monitoring health care provider.

Art Unit: 3762

In the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ECG monitoring of David to include a 12-lead ECG apparatus since it was well known in the art to provide for a conversion process or apparatus to convert the current ECG lead system to a 12-lead ECG apparatus for producing a complete and easily readable electrocardiograph data record which, in turn, results in more accurate diagnoses by the monitoring health care provider.

2. Claims 1, 2, 4-6, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn. Bornn discloses all of the claimed limitations including using different configurations of electrodes (column 9, lines 10-16) but does not explicitly speak to a 12-lead ECG apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ECG monitoring of Bornn to include a 12-lead ECG apparatus since it was well known in the art to use a 12-lead ECG apparatus for producing a complete and easily readable electrocardiograph data record which, in turn, results in more accurate diagnoses by the monitoring health care provider.

In the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ECG monitoring of Bornn to include a 12-lead ECG apparatus since it was well known in the art to provide for a conversion process or apparatus to convert the current ECG lead system to a 12-lead ECG apparatus for producing a complete and easily readable electrocardiograph data record which, in turn, results in more accurate diagnoses by the monitoring health care provider.

3. Claims 3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over David et al. (U.S. Patent No. 5,544,649). David discloses all of the claimed limitations but does not

Art Unit: 3762

explicitly speak to a WebTV appliance or an interactive Internet appliance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ambulatory patient health monitoring process and apparatus of David to use an interactive Internet appliance (WebTV) since it was well known in the art to use interactive Internet appliances and interactive cable television to easily transfer large amounts of voice, video and data concurrently so that one of ordinary skill would modify the health monitoring apparatus of David to include an interactive Internet appliance.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn et al. (US Patent No. 5,564,429). Bornn discloses all of the claimed limitations but does not speak to an interactive Internet appliance to transmit ECG data to the healthcare provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cardiorespiratory alert system of Bornn to include an interactive Internet appliance since it was well known in the art to use interactive Internet appliances, such as computers, to easily transmit large amounts of data via the Internet.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over David et al (U.S. Patent No. 5,544,649). David discloses all of the claimed limitations but does not explicitly speak to an infrared transmitter and an infrared receiver as the wireless communication interface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ambulatory patient health monitoring process and apparatus of David to use an infrared received and transmitter since it was well known in the art to use infrared transmission schemes in health monitors for transmitting and transferring data over short distances and for ease of use of the monitors without the burden of transmission lines potentially getting tangled.

Art Unit: 3762

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn et al. (US Patent No. 5,564,429). Bornn discloses all of the claimed limitations but does not explicitly speak to an infrared transmitter and an infrared receiver as the wireless communication interface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ambulatory patient health monitoring process and apparatus of Bornn to use an infrared received and transmitter since it was well known in the art to use infrared transmission schemes in health monitors for transmitting and transferring data over short distances.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn et al. (US Patent No. 5,564,429) in view of Morgan et al. (US Patent No. 5,782,878). Bornn discloses all of the claimed limitations but does not speak explicitly to a GPS system connected to the wireless communication interface. Morgan teaches an external defibrillator with a communication network having a GPS system for allowing remote determination of the location of a patient by a health care provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cardiorespiratory alert system of Bornn and include a GPS system, as taught by Morgan for allowing a remote health care provider to determine the location of the patient.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bornn et al. (US Patent No. 5,564,429) in view of Morgan et al. (US Patent No. 5,782,878). Bornn, in view of Morgan, discloses all of the claimed limitations but does not speak explicitly to the GPS system being enabled by the health care provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cardiorespiratory alert system of Bornn to include a means to enable the health care provider to enable the GPS system since it was well

Art Unit: 3762

known in the art to allow a remote health care provider to control local, ECG monitor functionality, especially a GPS system, and one ordinary skill would allow for remote enablement of the GPS system to locate the patient when he/she is distressed and unable to communicate his/her location.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar A Khan whose telephone number is (703) 308-0959. The examiner can normally be reached on M-F 9AM-6PM.

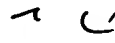
Art Unit: 3762

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.


1/30/03

Omar A Khan
January 30, 2003


GEORGE R. EVANISKO
PRIMARY EXAMINER

1/30/3